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True, the words were written by another ; the probate is compulsory ; but probate of a harmless, not an injurious instrument. And, above all, in cases like this, where the injurious and offensive matter may be removed without violence to or effect upon the determination and validity of the bequest.

J. C. A.

PATENTS—RIGHTS UNDER CONFLICTING DECISIONS—As the Circuit Courts are not bound by each other's decrees, a prior adjudication of a patent will not determine its status in another circuit,¹ and it not infrequently happens that the same patent is held invalid, or not infringed by a certain device in one circuit and valid and infringed by an identically similar device in another circuit. Until the decision of *Kessler v. Eldred*,² it was generally believed (though there were no adjudicated cases on the point) that the validity or invalidity of a patent was limited by the geographical boundaries of the circuit where the decree was rendered, and that an article, made under a decree declaring a patent invalid, could not be sold in another circuit where the patent had been held valid. This at least afforded a workable rule.

In that case, however, *Eldred*, the owner of the Chambers patent for electric cigar lighters, sued *Kessler* in the Northern District of Indiana, where it was held that *Kessler's* lighter did not infringe. Subsequently a similar lighter made by *Kirkland* in the Second Circuit was held to infringe. *Eldred* then sued *Breitweiser*, who was using *Kessler's* lights in the Second Circuit. But *Kessler* obtained a decree enjoining *Eldred* from prosecuting anyone for infringement of the Chambers patent by purchase, use or sale of the lighters made by *Kessler*. The United States Supreme Court held on *certiorari* that *Kessler* had the right to manufacture and sell his lighters throughout the United States and that a suit against any customer of his was a wrongful interference with his business.³

The decision is strictly limited to the rights of the successful infringer, the court expressly refusing to determine whether his

¹ *Mast v. Stover*, 177 U. S. 485 (1900); *Welsbach v. Cosmopolitan*, 104 Fed. Rep. 83 (1900); *Imperial v. Crown*, 139 Fed. Rep. 312 (1905); 18 HARV. L. REV. 217.

² 206 U. S. 285 (1906).

³ This doctrine includes interference with customers in a foreign country; *Goodyear Tire Co. v. Rubber Tire Co.*, 164 Fed. Rep. 869 (1908), and allows an injunction to prevent an interference *pendente lite*; *Commercial Co. v. Avery Lighting Co.*, 159 Fed. Rep. 935 (1908), but does not include the sale of any infringing article made in this district where the patent was held invalid; *Consolidated Co. v. Diamond Rubber Co.*, 157 Fed. Rep. 677 (1907).

customers had any rights in themselves or not,⁴ and has resulted in the utmost uncertainty and confusion.⁵

Probably no better example of the present chaotic state of the law can be found than the cases involving the Grant patent. This was a patent for a solid rubber tire composed of three elements: (1) a channel or groove with tapered or inclined sides, (2) a rubber tire with a described shape, adapted to fit into the channel, and (3) a fastening device consisting of independent retaining wires which pass through the tire. In the Sixth⁶ and Seventh Circuits⁷ the patent was held void. In the Second Circuit the patent was held valid.⁸ The Supreme Court of the United States affirmed the last decision in this circuit that the patent was valid and infringed by the defendant.⁹ In the decree, however, it was specifically stated that the injunction was not to prevent the defendant from using and selling the tires made by the Goodyear Company and the Kokomo Company under the prior decrees in the Sixth and Seventh Circuits.¹⁰

The question then arose between the exclusive licensee of the patentee and a purchaser in the Second Circuit from the Kokomo

⁴ Though if the manufacturer will undertake the defense of its customer it brings the case within the rule, *Marshall v. Bryant Electric Co.*, 185 Fed. Rep. 499 (1911), affirming 169 Fed. Rep. 426 (1909).

⁵ In commenting on the situation *Macombe in The Fixed Law of Patents* (2nd Ed., p. 5) says: "The decision in *Kessler v. Eldred*, 206 U. S. 285, is a step which does little more than add confusion to uncertainty. . . . Here then is the situation in part at least: If one buys a cigar lighter from Kessler in Illinois or anywhere else he may use it anywhere, even in the Second Circuit where the patent has been held valid. If one buys that cigar lighter from another maker than Kessler, he may use it in the Seventh Circuit and not infringe; but if he brings it into the Second Circuit and uses it he at once infringes. If one makes such a lighter in the Second Circuit he infringes; but he may carry it into the Seventh Circuit and use it freely. If a user of such cigar lighter were sued in the Second Circuit by Eldred for infringement of his patent and an injunction asked, the court would exclude from the restriction (as was done in the case of *Consolidated v. Diamond*) all lighters made by Kessler. What might happen in any one of the other seven circuits one may only surmise."

⁶ *Goodyear Co. v. Rubber Co.*, 116 Fed. Rep. 363 (1902); *Rubber Co. v. Victor Co.*, 123 Fed. Rep. 85 (1903).

⁷ The Circuit Court of the district of Indiana in the case of the *Consolidated Co. v. Kokomo*, not reported, dismissed the complaint upon the pleadings, testimony and exhibits for want of equity, no opinion being written. The case was then appealed to the U. S. Circuit Court of Appeals of the Seventh Circuit and thereupon dismissed.

⁸ *Consolidated Co. v. Finley Co.*, 116 Fed. Rep. 629 (1902); *Consolidated Co. v. Firestone Co.*, 147 Fed. Rep. 739 (1906); affirmed on appeal in 151 Fed. Rep. 237 (1907); *Consolidated Co. v. Diamond Co.*, 157 Fed. Rep. 678 (1907), and on rehearing, 162 Fed. Rep. 892 (1908).

⁹ *Consolidated Co. v. Diamond Co.*, 220 U. S. 428 (1911).

¹⁰ But the court refused to decide whether the defendant could use and sell its own tires in the circuits where the patent had been held invalid.

Company. The Circuit Court adopted the view that the decision in *Eldred v. Kessler* was purely one of *res judicata* and that inasmuch as the prior decree in favor of the Kokomo Company was purely in personam it could not be taken advantage of by its assignee.¹¹ But the Circuit Court of Appeals being in doubt as to whether this was the correct interpretation or not, certified to the United States Supreme Court¹² the question as to whether, in view of the subsequent holding of that court, the Kokomo Company had the right, as demanded by them, to manufacture and sell infringing tires everywhere free from the monopoly of the patent; and if so were its vendees immune from prosecution by the owners of the patent.

The determination of these questions would obviously have gone a long way towards clearing up the situation. Nevertheless the Court refused to decide the questions and distinguished the case on the narrow ground that the defendants did not purchase the patented article from the Kokomo Company but made it themselves, since they merely bought the rubber from the Kokomo Company and used their own metal channels and retaining wires.¹³ The same was held to be true where the defendants having bought the rubber only from the Kokomo Company sold the rubber and iron and wires to their purchasers to assemble.¹⁴ It is to be noted, however, that in this case the sole ground on which the patent was sustained, was that the elements only when assembled produced a patentable combination, but each alone was old, and therefore the decision is probably an extremely narrow one.

In view of the obvious reluctance of the United States Supreme Court to determine these questions finally and the absolute impossibility of any uniform ruling being reached through the Circuit Courts, since the decrees of one are not binding in another, it is submitted that the necessity for a Court of Patent Appeals is almost imperative.

T. S. P.

¹¹ *Hurd v. Seim*, 189 Fed. Rep. 591 (1911); *Hurd v. Woodward Co.*, 190 Fed. Rep. 28 (1911). For discussion see 25 HARV. L. REV. 650.

¹² *Hurd v. Seim*, 191 Fed. Rep. (1912); *Hurd v. Woodward*, 191 Fed. Rep. 835 (1912). In the meantime the court refused to grant a preliminary injunction. See also *Hurd v. James Goold Co.*, 203 Fed. Rep. 998 (1913).

¹³ *Seim v. Hurd*, 232 U. S. 420 (1914). A similar decision was made in *Rubber Co. v. Goodyear Co.*, 232 U. S. 413 (1914).

¹⁴ *Woodward v. Hurd*, 232 U. S. 428 (1914).